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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,819	02/22/2002	Edward O. Clapper	ITL.0694US (P13225)	3076
21906	7590	09/29/2006	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/081,819	CLAPPER, EDWARD O.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Olisa Anwah	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 15-22, 24 and 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14, 23, 25-30 and 38-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 9, 23, 25-27 and 39-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bodnar et al, U.S. Patent No. 6,658,268 (hereinafter Bodnar) combined with Smith, U.S. Patent Application Publication No. 2002/0174110 (hereinafter Smith) in further view of Albal et al, U.S. Patent Application Publication No. 2003/0147518 (hereinafter Albal).

Regarding claim 9, a system comprising:

a personal-use device (see unit 20 from Figure 1A) that is standalone, portable, and separate from a telephone (see unit 30 from Figure 1A) and another personal-use device (see desktop personal computer from column 2), the standalone device including an interface to connect said standalone device to a telephone line and including another interface to connect said

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standalone device to the other personal-use device, the standalone, portable device having:

a processor;

a storage coupled to said processor to store a first database with a plurality of records, each containing a telephone number, a name, and other information; and

an application stored in said storage to enable said processor to access the telephone number of a second party to an ongoing telephone call, search said first database for a record containing the telephone number, and display a name, telephone number, and other information associated with said record on the standalone, portable device (see column 13, line 60 through line 10 of column 14).

Still on the issue of claim 9, Bodnar fails to show that if the record is not found in the first database, said application to enable said processor to automatically initiate a search for information relating to said telephone number on a second, remotely located database, and to display information obtained from said second database on said standalone, portable device. Regardless, Smith discloses this feature (see Figure 2). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bodnar with

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the method for maintaining remotely accessible information taught by Smith. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

Further regarding claim 9, the combination of Bodnar and Smith fails to show the information obtained from the second database is displayed on the standalone, portable device during the ongoing call. All the same, Albal discloses this feature (see paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar and Smith with the method of delivering caller identification information disclosed by Albal. This modification would have improved the system's user friendliness by allowing the user to know the name of the caller before choosing to answer the phone call as suggested by Bodnar (see column 14).

Regarding claim 23, Bodnar discloses a method comprising:  
receiving in a standalone, battery-powered, and transportable device (see unit 20 from Figure 1A) a search query

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for information associated with a second party during a telephone call, the device separate from a telephone (see unit 30 from Figure 1A) and a personal computer (see desktop personal computer from column 2) and separately connectable to a telephone line (see Figure 1A) and the computer (see column 2); and

obtaining the information from the device if the information is present in the device (see column 13, line 60 through line 10 of column 14).

With further respect to claim 23, Bodnar fails to teach searching at least the personal computer for the information if the information is not present in the device. Regardless, Smith discloses this feature (see Figure 2). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bodnar with the method for maintaining remotely accessible information taught by Smith. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

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Further regarding claim 23, the combination of Bodnar and Smith fails to show providing the information to the device from the personal computer to display the information on the device during the telephone call. All the same, Albal discloses this feature (see paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar and Smith with the method of delivering caller identification information disclosed by Albal. This modification would have improved the system's user friendliness by allowing the user to know the name of the caller before choosing to answer the phone call as suggested by Bodnar (see column 14).

Regarding claim 25, from Bodnar see column 13, line 60 through line 10 of column 14.

Regarding claim 26, from Bodnar see column 13, line 60 through line 10 of column 14.

Regarding claim 27, see column 11 of Bodnar

Regarding claim 39, see column 11 of Bodnar

Regarding claim 40, see column 11 of Bodnar.

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Regarding claim 41, see column 9 of Bodnar.

Regarding claim 42, see Figure 1A of Bodnar.

Regarding claim 43, from Bodnar see column 13, line 60 through line 10 of column 14.

Regarding claim 44, see Figure 1A of Bodnar.

Regarding claim 45, from Bodnar see column 13, line 60 through line 10 of column 14.

Regarding claim 46, from Bodnar see column 13, line 60 through line 10 of column 14.

Regarding claim 47, see column 10 of Bodnar.

Regarding claim 48, see Figure 1A of Bodnar.

Regarding claim 49, Bodnar discloses a portable, standalone, personal-use device (see unit 20 from Figure 1A) comprising:

a processor having a memory;



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a local database coupled to said processor and to store records containing telephone numbers, names, and other information;

a search engine to run on said processor and to search said database for a record containing a telephone number of a second party to an ongoing telephone call;

a display coupled to the processor to display information obtained from said local database, the information obtained from the local database to be displayed while said call is in progress; and

a housing to house said processor, database, search engine, said housing to enable viewing of said display (see column 13, line 60 through line 10 of column 14).

Further regarding claim 49, Bodnar does not teach the device includes a search initiator to run on said processor and to initiate a search for information associated with the second party on an external, remote database if the search engine does not find a record containing the telephone number; wherein if information is not found on said local database, to display information obtained from said remote database; wherein the housing houses the search initiator. Regardless, Smith discloses this feature (see Figure 2). As a result, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to modify Bodnar with the method for maintaining remotely accessible information taught by Smith. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

Still on the issue of claim 49, the combination of Bodnar and Smith does not clearly show that the information obtained from the external, remote database is displayed while said call is in progress. All the same, Albal discloses this feature (see paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar and Smith with the method of delivering caller identification information disclosed by Albal. This modification would have improved the system's user friendliness by allowing the user to know the name of the caller before choosing to answer the phone call as suggested by Bodnar (see column 14).

Regarding claim 50, see Figure 1A of Bodnar.

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Regarding claim 51, see Figures 2A-B of Bodnar.

Regarding claim 52, see Figures 2A-B of Bodnar.

Regarding claim 53, see column 10 of Bodnar.

Regarding claim 54, see column 10 of Bodnar.

3. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Bodnar combined with Smith and Albal in further view of Fujiwara, U.S. Patent No. 6,270,271 (hereinafter Fujiwara).

As per claim 38, nowhere does the combination of Bodnar, Smith and Albal show a printer is housed in the portable device. Nonetheless, Fujiwara discloses this limitation (see abstract). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar, Smith and Albal with the printer of Fujiwara. This modification would have improved the system's convenience by allowing the user to obtain a print output at any time and anywhere as suggested by Fujiwara (see column 7).

4. Claims 10-13, 29 and 30 are rejected under 35 U.S.C § 103(a) as being unpatentable over Bodnar combined with Smith and

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Albal in further view of Suzuki, U.S. Patent Application  
Publication No. 2001/0027098 (hereinafter Suzuki).

On the issue of claim 10, the combination of Bodnar, Smith and Albal fails to teach the application includes instructions to automatically initiate a search for information related to said record in a second database, and if information is not found in said second database, automatically initiate a search for the information on a third, remotely located database. Nonetheless, Suzuki discloses this feature (see Figure 6). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar, Smith and Albal with the information processing system of Suzuki. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

Regarding claim 11, see Figure 2 of Smith.

Regarding claim 12, see Figure 2 of Smith.

On the issue of claim 13, the combination of Bodnar, Smith and Albal fails to teach the storage stores a user preference

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table that indicates a preferred search hierarchy among a plurality of databases. Nonetheless, Suzuki discloses this feature (see paragraph 0072). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar, Smith and Albal with the information processing system of Suzuki. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

Claim 29 is rejected for the same reasons as claim 13.

Regarding claim 30, see Figure 2 of Smith.

5. Claims 14 and 28 are rejected under 35 U.S.C § 103(a) as being unpatentable over Bodnar combined with Smith and Albal in further view of Pardo, U.S. Patent No. 6,266,539 (hereinafter Pardo).

Regarding claim 14, the combination of Bodnar, Smith and Albal does not teach the storage stores a sequential listing of telephone numbers of outgoing telephone calls and caller identification information for incoming telephone calls. Yet

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Pardo shows this feature (see column 6). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Bodnar, Smith and Albal with the call log of Pardo. This modification would have improved the system's convenience by providing an integrated solution such that information on each device remains available for use in other devices in a convenient, transparent manner as suggested by Bodnar (see column 2).

Claim 28 is rejected for the same reasons as claim 14.

#### ***Response to Arguments***

6. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

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action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

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O.A.

Olisa Anwah

Patent Examiner

September 22, 2006

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 26.